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TO: Examiner John P. Zimmermann
 Group Art Unit 2861

FROM: Michael K. O'Neill

RE: U.S. Application No. 10/566,173
 Atty. Docket No.: 01272.519030

FAX NO.: (571) 273-8300

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MESSAGE

Attached is a Response to the Restriction Requirement October 26, 2007.

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
KIYOMITSU KUDO, et al.) : Examiner: J. Zimmermann
U.S. Application No.: 10/566,173) : Group Art Unit: 2861
§ 371(c) Date: January 27, 2006) :
Int'l Appln. No.: JP2005/07757) :
Int'l Filing Date: April 19, 2005) :
For: INK CONTAINER, INK)
JET PRINTING HEAD,)
AND INK JET PRINTING)
APPARATUS) : November 26, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT
AND
STATEMENT SUMMARIZING INTERVIEW

Sir:

This is a response to the restriction requirement dated October 26, 2007.

Applicants provisionally elect Group I, Claims 1, 2 and 4 to 10, drawn to an ink container for containing ink. The requirement is respectfully traversed, as explained below in connection with a telephone interview conducted with the Examiner.

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(Name of Attorney for Applicant)

Signature **Date of Signature**

STATEMENT SUMMARIZING INTERVIEW

This summarizes a telephone interview conducted with the Examiner on November 19, 2007.

The Examiner advised that it was his intention to require restriction between the following three groups of claims:

Group I: Claims 1, 2 and 4 to 40, drawn to an ink container;

Group II: Claims 11, 12 and 14 to 16, drawn to an ink jet printing head; and

Group III: Claims 17 to 21, drawn to an ink jet printing apparatus.

The Examiner further stated that if election of one of these three groups were made, then it would constitute a complete response to his Office Action. He specifically stated that there would be no need to respond to other requirements for election between species, for the reason that his requirement to elect was intended to require election between embodiments that supplied ink and embodiments that consumed it. This intention was adequately reflected in the above restriction requirement, between the Group I, II and III claims.

Even as modified by the Examiner during this telephone conversation, the requirement to restrict is respectfully traversed. Three reasons are given for traversal. First, the restriction requirement was predicated under PCT Rule 13.2 because the "groups listed above are not within the permitted combination of different categories of invention". See Office Action, page 3. However, as correctly stated at MPEP § 1850, PCT Rule 13.2

was modified more than 15 years ago, and no longer requires combinations of categories of invention:

"PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Those categories, which now appear as a part of Chapter 10 of the International Search and Preliminary Examination Guidelines, may be obtained from the Patent Examiner's Toolkit link or from WIPO's website (www.wipo.int/pct/en/texts/gdlines.htm). The categories of invention in former PCT Rule 13.2 have been replaced with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Chapter 10 of the International Search and Preliminary Examination Guidelines also contains examples concerning unity of invention." (MPEP § 1850, page 1800-98, Rev. 6, Sept. 2007).¹⁴

Indeed, the current language of PCT Rule 13.2 contains no mention of combinations of categories of invention:

"13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

"Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

¹⁴The quoted section of MPEP § 1850 refers to "International Search and Preliminary Guidelines", available from WIPO's website. The cited guidelines will hereinafter be referred to as "PCT Guidelines".

Thus, the requirement for restriction is traversed for the reason that it is based on a faulty reading of an outdated version of PCT Rule 13.2.

As a second reason for traversal, although the restriction requirement states that the three groups are not within permitted combinations of different categories of invention, under PCT rules, there are only two categories of invention. See PCT Guideline 5.12:

"There are two basic kinds of claims, *viz.*, claims to a physical entity (product, apparatus) and claims to an activity (process, use)".

Thus, there are only two categories of apparatus or process, and all claims of the three identified groups fall within the single category of "apparatus". It is therefore not possible for the claims to define combinations of "different" categories of inventions, since all three groups fall within the singular category of apparatus.

As a third reason for traversal, although the Office Action states that the International Search Report (Form 210) indicates that there is no special technical feature that defines a contribution over the prior art, the Written Opinion in this case states that all dependent claims define over the art. In accordance with the Article 19 Amendments submitted and entered for this case, Claims 3 and 13 have been cancelled and incorporated into each of the independent claims. There is therefore clearly a technical feature that defines over the art.

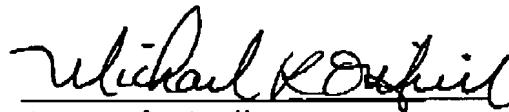
In view of these three reasons for traversal, and further in view of the fact that a non-unity invention was not entered during International Search or Preliminary Examination, it is respectfully requested to withdraw the requirement for restriction.

Finally, the telephone interview also discussed the Examiner's comment, at paragraph 1 of the Office Action, that Claim 17 is an improperly multiply-dependant claim. The Examiner confirmed that he was mistaken on this point, since Claim 17 is a multiply-dependent claim that depends only on singly-dependent claims. However, the Examiner stated that he would require an amendment to Claim 17, so as to reflect the cancellation of Claims 3 and 13.

In view of the foregoing, it is respectfully requested to withdraw the requirement for restriction, and to examine all claims on the merits.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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